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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,320	03/06/2002	Jack R. Kries	DP-306837 7500/141	9018

7590 04/14/2004

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EXAMINER

GRAHAM, MATTHEW C

ART UNIT

PAPER NUMBER

3683

DATE MAILED: 04/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 10

Application Number: 10/092,320
Filing Date: March 06, 2002
Appellant(s): KRIES ET AL.

Frank C. Nicholas
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/9/2004

• Art Unit: 3683

This is in response to the brief on appeal filed 1/9/2004

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-18 stand or fall together because appellant's brief does not include reasons in support of proposed groupings. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

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The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

6,505,822 Yamamoto et al. January 14, 2003

5,782,462 Hein et al. June 21, 1998

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-18 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 5.

Also note the Appellants claim a periphery and not a peripheral edge. A periphery is defined as a portion near the edge. Yamamoto et al show a periphery as broadly claimed spaced apart from the lower plate.

(11) Response to Argument

Appellant's arguments appear on pages 5-13 of the brief and may be summarized as follows:

1. The examiner has used impermissible hindsight.
2. There is no motivation for the combination.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

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reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is well known in the art to provide for damping of different frequency ranges by allowing flow around a decoupler or diaphragm as is taught by Hein et al. In addition, please note that the periphery is spaced apart in Yamamoto et al as broadly claimed.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

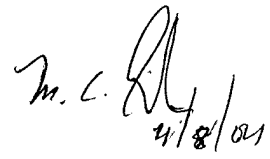
Matthew C. Graham
April 8, 2004

Conferees

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